

USSN: 10/071,570

Attorney Docket R0134A ORD

REMARKS

Claims 2-3, 6, 20 and 22-24 are currently pending in this case. Claims 4-5 and 7-19, are withdrawn from prosecution. Claims 1, 21 and 25 are canceled by this Amendment. Claims 2, 3, 20, 22 and 24 are amended herein.

1. Priority

The Applicants note with appreciation that acknowledgment has been made of Applicants' claim of foreign priority to EP 01109853.0 filed April 23 2001.

2. Changes To The Specification

The Examiner previously indicated, in the Office Action mailed on September 10 2003, that the above-identified application fails to comply with the sequence listing requirements of 37 CFR § 1.182 through 1.185. The Applicants have amended the specification to delete references to amino acid sequences that are subject to the sequence listing requirements of 37 CFR § 1.182 through 1.185. The Applicants note that the deleted subject matter relates only to canceled claims 1, 21 and 25. The Applicants believe that the specification as amended conforms to the requirements of 37 CFR § 1.182 through 1.185.

3. Objection To Claim 20

The Examiner objected to claim 20 because of an informality resulting from a typographical error, for which Applicants apologize. The Applicants' have corrected this error by including the omitted "a" in claim 20.

4. Claim Rejection Under 35 USC §102

Claim 1 was rejected under 35 USC §102(b) as being anticipated by Fritz et al., WO 99/07681. The Examiner stated that Fritz et al. teaches the use of NK-1 receptor antagonists for the treatment of benign prostatic hypertrophy (p. 43 lines 23-25).

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The Applicants have canceled claim 1. Claims 2 and 3 have been amended to place these claims in independent form. Claims 22 and 24 have been amended to change their dependency from canceled claim 1 to claim 2.

5. Claim Rejections Under 35 USC §103

Claims 2, 3, 6, 20 and 22-24 were rejected as being unpatentable over Boes et al., GB 2347422 in view of Fritz et al., WO 99/07681. The Examiner pointed out that Boes et al. teaches use of the claimed compounds of formula (I) as NK-1 receptor antagonists.

Boes et al. GB 2347422 was published on September 06, 2000. The filing date for the priority application (EP 01109853.0) for the above-identified case is April 23, 2001, which is less than one year after the publication of GB 2347422. Thus, GB 2347422 qualifies as prior art under 35 USC §102(a).

Boes et al. GB 2347422 discloses and claims the same 4-phenyl-pyridine derivative NK-1 receptor antagonists recited in claims 2, 3, 6, 20 and 22-24 of the instant application. GB 2347422 relies for priority on European patent applications EP 99103504 and EP 99123689. U.S. Patent No. 6,297,375 to Boes et al. also relies on EP 99103504 and EP 99123689, and discloses and claims the same 4-phenyl-pyridine derivative NK-1 receptor antagonists as GB 2347422. U.S. Patent No. 6,297,375 and its priority applications EP 99103504 and EP 99123689 name the following persons as inventors:

Michael Boes;
Quirico Branca;
Guido Galley;
Thierry Godel;
Torsten Hoffman;
Walter Hunkeler;
Patrick Schnider; and
Heinz Stadler.

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As a result of typographical error by Applicants' foreign associate in Great Britain, or by the Patent Office of Great Britain, the names of Torsten Hoffman, Walter Hunkeler, Patrick Schnider, and Heinz Stadler were omitted from the GB 2347422 publication. These inventors, however, are properly named in corresponding U.S. Patent No. 6,297,375. Torsten Hoffman is thus a common inventor for the instant application as well as GB 2347422 and corresponding U.S. Patent No. 6,297,375.

An Applicant's disclosure of his or her own work within the year before the application filing date cannot be used against him or her under 35 USC §102(a). MPEP §2132. The Boes et al. GB 2347422 publication describes Applicant Torsten Hoffmann's own work, and cannot properly be used as a prior art reference against the instant application.

A rejection under 35 USC §102(a) may be overcome by submission of a specific declaration by the Applicant establishing that the cited publication is describing the Applicant's own work. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). Submitted herewith is the Declaration (37 CFR §1.132) of Applicant Torsten Hoffmann, averring that Torsten Hoffman is a co-inventor of the claims of the above-identified patent application, is also a co-inventor of the subject matter described and claimed in GB 2347422 published on September 06, 2000, and that the GB 2347422 publication describes Torsten Hoffmann's own work.

Accordingly, since base reference GB 2347422 cannot properly be used as a prior art reference against the instant application under 35 USC §102(a), Applicants respectfully request that the outstanding claim rejection under 35 USC §103 be withdrawn.

6. Nonstatutory Double Patenting

In the Office Action mailed on September 10, 2003, the Examiner provisionally rejected claims 1-3, 6 and 22-24, under the judicially created doctrine of double patenting, over the claims of co-pending Application No. 10/196,795. The Examiner indicated that a terminal disclaimer would overcome this rejection, provided that the conflicting application is shown to be commonly owned with this application.

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The subject matter of Application Ser. No. 10/196,795 and the instant application are commonly owned and were commonly owned at the time of invention. U.S. Application Ser. No. 10/196,795 was assigned by F. Hoffman-La Roche AG of Basel Switzerland to Hoffman-La Roche Inc. of Nutley New Jersey, as recorded at Reel 013260, Frame 0673. The above-identified patent application was assigned by F. Hoffman-La Roche AG to Syntex U.S.A. LLC, as recorded at Reel 012613, Frame 0441. Syntex U.S.A. LLC subsequently changed its name to Roche Palo Alto LLC on December 23, 2002, as shown by the statement of the Delaware Secretary of State, attached hereto as Exhibit A. Hoffman-La Roche Inc. and Roche Palo Alto LLC are each 100% owned by Roche Holdings Inc., which in turn is 100% owned by F. Hoffman-La Roche AG.

A terminal disclaimer in accordance with 37 CFR §1.321(c), disclaiming the patent term beyond that of co-pending Application No. 10/196,795, is submitted herewith.

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CONCLUSION

In view of the foregoing amendments and remarks, the Applicants respectfully submit that all of the presently pending claims in the above-identified case are in condition for allowance. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Please charge the fee for a two month Extension of Time pursuant to 37 CFR §1.136(a) to Applicants' deposit account No. 18-1700.

Respectfully submitted,



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